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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,969	11/29/1999	LYNN DOUCETTE-STAMM	PATH99-09A	8394

7590

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EXAMINER

SIEW, JEFFREY

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 03/04/2003

lf

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/450,969

Applicant(s)

DOUCETTE-STAMM ET AL.

Examiner

Jeffrey Siew

Art Unit

1656

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 11-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *stic report 2pgs*.

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## **DETAILED ACTION**

### **Location of Application**

1. The location of the subject application has changed. The subject application is now located in Group 1630, Art Unit 1637, and is assigned to Patent Examiner Jeffrey Siew.

### ***Election/Restrictions***

2. This application contains claims 11-31 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Pending claims to be examined are 1-10.

## **THE FOLLOWING IS A NEW GROUND OF REJECTION NECESSITATED BY THE AMENDMENT**

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 5 & 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Benton et al (US6,228,588 May 8, 2001).

Benton et al teach a SEQ ID NO:32 which has a length of 1810 bp. comprises a region bp. 720-754 which is fully complementary to the claimed SEQ ID NO: 1835. (see attached STIC report).

The region comprises 34 nucleotides which would encode greater than 10 amino acids.

Moreover, claim 10 reads on the sequence comprises at least 40 nucleotides not on the hybridizing region comprising 40 nucleotides. The term "hybridizable" reads broadly and would encompass Benton et al's SEQ ID NO:32 which contains a portion of fully complementary region.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benton et al (US6,228,588 May 8, 2001) in view of Fleischmann et al (US6,468,765 Oct. 22, 2002).

The teachings of Benton et al are described previously. They further teach vectors for protein expression (see col. 4 lines 14-20, col. 16 lines 50-col. 17 line 30 & col. 253 lines 9-12)

Benton et al do not explicitly teach vector with transcriptional regulatory element.

Fleischmann et al teach recombinant vector with transcriptional regulatory element (see col. 14 lines 43-67).

One of ordinary skill in the art would have been motivated to apply Fleischmann et al teachings of recombinant vectors to Benton et al's SEQ ID NO: 32 in order to express the *S. aureus* proteins for biochemical analysis. As it was well known and commonly practiced in the art to insert sequences to vectors to produce proteins from various infectious bacteria for the purpose of vaccinations and antibody production as taught by Fleischmann et al, it would have been prima facie obvious to apply Fleischmann et al's vectors to Benton et al's sequences in order to express Benton et al's *S. aureus* proteins for antibody production and vaccination studies.

### SUMMARY

5. Claims 1-4 & 9 are allowable. There is no prior art that teach an isolated nucleic acid comprising a nucleotide sequence encoding SEQ ID NO: 5607. There is no prior art that teach or suggest the probe containing at least 40 contiguous nucleotides from SEQ ID NO: 1835.

### CONCLUSION

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Siew whose telephone number is (703) 305-3886 and whose e-mail address is Jeffrey.Siew@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner is on flex-time schedule and can best be reached on weekdays from 6:30 a.m. to 3 p.m. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703)-308-1119.

Any inquiry of a general nature, matching or filed papers or relating to the status of this application or proceeding should be directed to the Tracey Johnson for Art Unit 1637 whose telephone number is (703)-305-2982.

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Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Center numbers for Group 1600 are Voice (703) 308-3290 and Before Final FAX (703) 872-9306 or After Final FAX (703) 30872-9307.

  
**JEFFREY SIEW**  
**PRIMARY EXAMINER**

February 28, 2003